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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,795	02/22/2002	Fredrik Kamme	PRI-0021 (ORT-1508)	9944

7590 04/23/2003

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EXAMINER

HASHEMI, SHAR S

ART UNIT	PAPER NUMBER
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1637

DATE MAILED: 04/23/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/080,795

Applicant(s)

KAMME ET AL.

Examiner

Shar Hashemi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 November 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☒ Claim(s) 3, 6 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Status of Application, Amendments, and/or Claims***

1. The "Associate Power of Attorney and Change of Correspondence Address" was received. The claims pending in this application are **Claim(s) 1-26**.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 03/19/02 was received. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Drawings***

3. The drawings are objected to because, in Figures 1 and 2, the photographs of the gel electrophoresis illustrate poor resolution of the bands. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

### ***Specification***

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4. The use of the trademark "Superscript" (page 29, line 5) has been noted in this application. Trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

#### ***Claim Objections***

5. Claims 3, 6 and 15 are objected to because of the following informalities: Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. The *preferred* form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." Amending the claims to incorporate Markush type language would obviate the rejection.

#### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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7. Claims 1-26 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Linsley et al (US 6,271,002 B1 August 7, 2001).

Linsley et al teach a method and kit for amplifying at least one mRNA in a sample containing a plurality of different mRNAs according claims 1-26 (see whole document, col. 4, lines 11-44; col. 4, lines 56-67; col. 5, lines 1-40; col. 5, lines 50-67; col. 10, lines 1-67; col. 11, lines 30-34; col. 11, lines 51-67; col. 13, lines 23-30; col. 16, lines 11-14; col. 17, lines 8-43; col. 19, line 55 to col. 20, line 38; col. 21, lines 7-67; col. 22, lines 55-67; col. 28, line 63 to col. 29, line 67).

### CONCLUSION

8. Claims 1-26 are rejected and claims 3, 6, and 15 are objected for the reasons set forth above.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shar Hashemi whose telephone number is (703) 305-4840. The examiner can normally be reached Monday-Friday from 8:00AM – 5:00PM EST or any time via voice mail. If repeated attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (703) 308-1119.

The fax number for this examiner is (703) 746-9038. Before faxing any papers, please inform the examiner to avoid lost papers. Please note the faxing of papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989). Any

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inquiry of a general nature or relating to the status of this application should be directed to the group receptionist, Tracey Johnson, whose telephone number is (703) 305-2982.

Examiner Hashemi

A handwritten signature in black ink, appearing to be 'P. Hashemi', written in a cursive style.A handwritten signature in black ink, appearing to be 'E. Whisenant', written in a cursive style.

Ethan Whisenant, Ph.D.  
Primary Examiner  
Art Unit 1634